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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/577,294 05/23/00 BLECKMANN

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EXAMINER

HM12/0910

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WELLS-L

ART UNIT

PAPER NUMBER

1619

DATE MAILED:

09/10/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/577,294	Applicant(s) BLECKMANN ET AL.	
	Examiner Lauren Q Wells	Art Unit 1619	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-12 are currently pending. Claims 7-12 were added by the Amendment received August 3, 2001 (Paper No. 8).

Priority

The Examiner hereby withdraws any request for a translation of the foreign priority, as was requested in the Office Action mailed January 30, 2001 (Paper No. 5).

Response to Applicant's Arguments/Amendment

The Applicant's arguments filed August 3, 2001 (Paper No. 8) to the rejection of claims 1-6 made by the Examiner under 35 USC 103 have been fully considered and deemed not persuasive. The rejection of claims 1-6 made by the Examiner under 35 USC 112 have been fully considered and deemed persuasive. Therefore, the said rejection is hereby withdrawn.

103 Rejection Maintained

The rejection of claims 1-6 and newly added claims 7-12 under 35 U.S.C. 103(a) as being unpatentable over Mellul (6,083,491) in view of Sine et al. (5,997,890) is MAINTAINED for the reasons set forth in the Office Action mailed January 30, 2001, Paper No. 5, and those found below.

Applicant argues that "Mullel does not teach anything at all about how to prepare water in oil emulsions. . .". This argument is not persuasive, as it is not commensurate in scope with independent claim 1. Independent claim 1 is drawn to a composition and not a method, thus the preparation of the composition is not relevant.

Applicant argues that "Mullel only mentions water-in-oil emulsions as one of the forms of his composition can take and specifically discloses only one water in oil emulsion and that

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emulsion has only 68% water. Moreover, the emulsion of Example K does not contain any alkylmethicone copolyol or alkylmethicone copolyols". This argument is not persuasive. The Examiner respectfully points out that Mullet is not used as an anticipatory reference and that the rejection based on the reference is not bound by the preferred embodiments disclosed in the invention, thus the inability of Example K to meet the limitations of the instant claims is not a persuasive argument. Furthermore, the Examiner respectfully points out that Mullet in view of Sine is relied upon to reject the percent weights of the components of the composition. Lastly, the Examiner points out that when all the gram weights of the constituents in Example K are added together, the total gram weight of the composition is 132 grams. Dividing the amount of water into this total gram weight of the composition and multiplying the product by 100, results in a composition comprising 77% water.

Applicant further argues that "Mullet has absolutely no specific teaching about any kind of emulsions". This argument is not persuasive, as a reference is not required to have specific teachings in a 103 obviousness rejection. Mullet discloses a water in oil emulsion therefore meeting the instant claims' limitations.

Applicant argues that "Sine does not actually teach anything at all about water in oil emulsions. . . Sine merely assumes that such exist and are typical". This argument is not persuasive. In Col. 10, lines 15-59, Sine actually teaches water in oil emulsions with 1-98% of a hydrophilic phase and 1-50% of a hydrophobic phase as carriers. Furthermore, Sine teaches the preparation of these types of emulsions as well known in the art. Again, a reference is not required to depict preferred embodiments in a 103 obviousness rejection. Sine discloses water in

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oil emulsions comprising 1-98% of a hydrophilic phase and 1-50% of a hydrophobic phase therefore meeting the percent weight limitations of the instant claims.

Both Sine et al. and Mellul et al. teach cosmetic compositions for topical application to the skin, both teach water in oil emulsions as possible cosmetic forms of their compositions, and both teach compositions comprising solid particles. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Mellul et al. using the teachings of Sine et al. and obtain a water in oil emulsions comprising 75% water and water soluble substances and 25% or less of lipophilic constituents.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-4:30).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diana L Dudash can be reached on (703) 308-2328. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and (703) 308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw
August 17, 2001

A handwritten signature in black ink, appearing to read "D. Jones", with a stylized, cursive script.

DAMERON L. JONES
PRIMARY EXAMINER